

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
98-092

In Re Application Of: JAY S. WALKER et al.

Serial No.
09/267,489

Filing Date
March 11, 1999

Examiner
REAGAN, James A.

Group Art Unit
3621

Title:
SYSTEM AND METHOD FOR MAILING LIST TESTING SERVICE

TO THE COMMISSIONER FOR PATENTS:

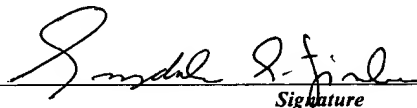
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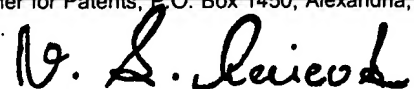
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CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)			Docket No.
Applicant(s): JAY S. WALKER et al.			98-092
Serial No. 09/267,489	Filing Date March 11, 1999	Examiner REAGAN, James A.	Group Art Unit 3621
Invention: SYSTEM AND METHOD FOR MAILING LIST TESTING SERVICE			
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REPLY BRIEF

RESPONSIVE TO
THE EXAMINER'S ANSWER MAILED ON APRIL 19, 2004

CUSTOMER NO. 22927

Appellants: Jay S. Walker, Magdalena Mik Fincham, Daniel E.
Tedesco and Dean Alderucci
Application No.: 09/267,489
Filed: March 11, 1999
Title: SYSTEM AND METHOD FOR MAILING LIST
TESTING SERVICE

Group Art Unit: 3621
Examiner: Reagan, James A.

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1. SUMMARY OF ARGUMENTS

As discussed in the Supplemental Appeal Brief mailed on February 27, 2004 (which replaced the originally filed Appeal Brief mailed on September 11, 2003), the rejections are erroneous for several reasons.

1.1. First Limitation in All Claims Not Suggested by the References

As argued in the Supplemental Appeal Brief, Section 1.3.1, 1.4.1, pages 19 - 32, none of the references, alone or in combination, teach or suggest ANY METHOD FOR SELECTING FOR USE A MAILING LIST FROM A PLURALITY OF MAILING LISTS.

Accordingly, none of the references, alone or in combination, teach or suggest the narrower limitation (present in all claims) of:

selecting for use a postal mailing list from a plurality of postal mailing lists, based on responses received to an e-mail message that was sent, for each of the plurality of postal mailing lists, to each of a subset of list members

The Examiner's Answer does not even address, much less refute or rebut, Appellants' specific arguments regarding this claim limitation.

As discussed in the Supplemental Appeal Brief, all references are merely directed to methods for *compiling* or *creating* a mailing list, **not** any method for selecting a mailing list for use. The references utterly fail to address how an entity would select, for use, a mailing list from a plurality of mailing lists.

1.2. Second Limitation in All Claims Not Suggested by the References

As argued in the Supplemental Appeal Brief, Section 1.3.2 and 1.4.2, pages 25, 26, 33 and 34, none of the references, alone or in combination, teach or suggest that ANY E-MAIL MESSAGES ARE SENT TO ANY MEMBERS OF A POSTAL MAILING LIST

Accordingly, none of the references, alone or in combination, teach or suggest the narrower limitation (present in all claims) of:

sending an e-mail message to a subset of list members for each list of the plurality of postal mailing lists.

1.3. No Substantial Evidence to Support Other Factual Assertions

As argued in the Supplemental Appeal Brief, Section 1.3.1, page 24 and Section 2.3.1, page 38, the rejection of Groups I and II is further improper for being based on factual assertions unsupported by any evidence in the record.

No evidence has ever been provided, yet the Examiner continues to rely on the unsupported assertions as the basis for rejecting all claims.

Examiner's Answer, pages 14 and 16.

This error is discussed in further detail below in Section 2.2.

1.4. Appellants' Interpretation of the References Remains Unchallenged

In the Examiner's Answer the Examiner has not provided any new arguments as to how any of the references teach or suggest the claimed features. Rather, the Examiner has merely repeated, almost verbatim, the language of the Office Actions issued for the present application (which were essentially duplicates of one another).

Accordingly, the Examiner, both during prosecution and in the Examiner's Answer, has not even attempted to clarify how the references could teach or suggest the claimed features, despite Appellants' detailed arguments that the references do not teach or suggest the claimed features.

Further, neither in prosecution nor in the Examiner's Answer has the Examiner ever disagreed with any of Appellants' interpretations of the references or provided any evidence or arguments contrary to such interpretations. Appellants' un rebutted interpretations and arguments make clear that the claim features are not taught or suggested by the prior art.

2. REBUTTAL OF ARGUMENTS PRESENTED IN THE EXAMINER'S ANSWER

Appellants respond to the following assertions provided for the first time in the Examiner's Answer.

2.1. THE NEW MOTIVATION TO COMBINE REFERENCES DOES NOT RESULT IN THE CLAIMED COMBINATION

On pages 12, 13, 15, 17, 18, and 19 of the Examiner's Answer, the Examiner asserts the following new motivation to combine the references:

“Furthermore, Appellant, in the background of the specification specifically states, ‘this is because the best list can often result in 10 times the response as the worst list for an identical mailing piece (page 2, lines 4 – 10).’[sic] Here, the Appellant is specifically stating the relative value of the accurate, updated, and complete mailing list, and that multiple mailing lists are known to one of ordinary skill in the direct mailing arts.”

This motivation was not previously introduced as a basis for rejection of any claim. The motivations to combine that had previously been provided can be found, e.g., Third Office Action, page 6, end of first full paragraph, Fourth Office Action, page 5, end of first paragraph and Fourth Office Action, middle of page 5.

This newly provided motivation to combine fails to establish a *prima facie* case of obviousness. Even if this statement from the specification could be considered a sufficient motivation to combine the references, the combination still would not teach the claimed features argued with respect to GROUPS I through VI.

The statement from the specification merely states that the “best” list can result in a relatively high response rate. This motivation, when used to combine the cited references (which each disclose a method for *compiling* a mailing list), would at best result in motivating one of ordinary skill in the art to *compile* “the best” mailing list.

In contrast, this new motivation would not cause one of ordinary skill in the art to recognize a method for *selecting for use* a postal mailing list from a plurality of postal mailing lists, much less the claimed method of *selecting for use a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message that had been sent, for each of the plurality of postal mailing lists, to a subset of list members*. This failing exists at least because none of the references teach (i) selecting a postal mailing list from a plurality of postal mailing lists, nor (ii) sending an e-mail message to a subset of list members for each postal mailing list in a plurality of postal mailing lists, nor (iii) selecting the postal mailing list from the plurality of postal mailing lists based on the responses to such an e-mail message.

Further, the statement in the specification referring to “the best list” is not even analogous to an “accurate, updated, and complete mailing list”. Appellants have never, in the background of the specification or elsewhere, asserted that a “best” mailing list is equivalent to an “accurate, updated, and complete mailing list.” To be the “best”, a mailing list need only be better than the other mailing lists to which it is compared. There is no implication that the best of a set of mailing lists is accurate, updated or complete. In fact, the record shows that it was recognized and accepted that mailing lists were inaccurate, out of date and incomplete. Such faulty mailing lists were

still used with various degrees of effectiveness. See, e.g., Druckenmiller, Col. 1, lines 12 – 53 and McEvoy, col. 1, line 59 through col. 2, line 16.

2.2. UNSUPPORTED ASSERTIONS IMPROPERLY RELIED UPON IN REJECTIONS

As argued in the Supplemental Appeal Brief, Section 1.3.1, page 24 and Section 2.3.1, page 38, the rejection of Groups I and II is further improper for being based on factual assertions unsupported by any evidence in the record - namely the Examiner's assertions that:

"the selection of the most accurate, most valuable, and most recent mailing lists is obvious to any organization that intends to increase profitability by direct or electronic mailing to selected recipients...it is not only obvious but also inherent to the profitable company to select mailing lists that are current and verified...effective mailing lists are more valuable than old, untested lists."

In fact, the Examiner never even alleged that any reference of record supports these assertions. Although Appellants requested a reference to support these assertions, none was ever provided. See, e.g., Appellants' Amendment and Response mailed October 30, 2002, page 10.

Since there is no substantial evidence to support the assertions, the Examiner has not yet presented a *prima facie* case of unpatentability.

Appellants are not required to present any evidence in the absence of a *prima facie* showing of unpatentability. Nevertheless, Appellants submitted an affidavit of an expert who asserted that prior to Applicants' claimed

invention it was unknown to test the effectiveness of mailing lists in any way. This evidence contradicts the Examiner's unsupported assertions.

Thus, not only does the record completely lack any evidence to support the Examiner's factual assertions, the record demonstrates that in fact the opposite was true.

The Examiner denies using Official Notice in the rejection of the claims. Examiner's Answer, pages 12 and 15. Nevertheless, the Examiner continues to use the unsupported assertions as the basis for the rejection of the claims. Examiner's Answer, pages 14 and 16.

2.3. INCORRECT CHARACTERIZATION OF APPELLANTS' ASSERTIONS

In the Examiner's Answer, page 16, the Examiner states that in Section 2.4.1 of the Supplemental Appeal Brief, Appellants asserted that “there is no showing that the references suggest selecting for use...”.

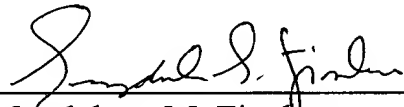
In fact, in that section Appellants asserted that “the references do not show selecting for use....”. It was in Section 2.3.1 of the Supplemental Appeal Brief that Appellants asserted that the “there is no showing that the references suggest selecting for use...”.

CONCLUSION

Appellants respectfully request that the Examiner's rejections be reversed for the reasons specified in this Reply Brief and in the Supplemental Appeal Brief.

Respectfully submitted,

June 17, 2004
Date



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